

-- REMARKS --

The present amendment replies to an Office Action dated July 5, 2007. Claims 1-23 are pending in the present application. Claims 17 and 22 have been amended herein. In the Office Action, the Examiner rejected pending claims 1-23 on various grounds. The Applicants respond to each ground of rejection as subsequently recited herein and respectfully request reconsideration of the present application.

35 U.S.C. §112

Claims 1, 17, and 22 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Should the Examiner maintain this rejection, the Applicants respectfully request that the Examiner clearly identify which claims are being rejected. Section 3 of the Detailed Action of the Office Action dated July 5, 2007, refers to dependent claim 11 which seems to be unrelated to the 35 U.S.C. §112, second paragraph, rejection and refers to claim 1 without directly identifying the statutory basis for rejection.

The Examiner rejected claims 17 and 22 as being unclear as to why one would complete a transaction and then add the funds transfer static data and the funds transfer status data to the payment input data to form funds transfer data. The Applicant respectfully points out that the transaction is being completed to the point of payment. Customer 20 selects items to purchase or bills to pay and completes the transaction to the point where payment is required. *See* US 2002/0055907 - [0027]. Adding the funds transfer static data and the funds transfer status data to the payment input data to form funds transfer data assembles all the payment information for the transaction, so that the payment can be made over any electronic funds transfer network when the funds transfer conditions are met. *See* US 2002/0055907 – Figure 2.

The Examiner rejected claims 17 and 22 as being unclear as to what happens if conditions are not met. Claims 17 and 22 have been amended herein to delete the waiting and to clarify that the extracting occurs when the conditions are met.

The Examiner rejected claim 1 as being unclear as to storing funds transfer status data before executing the transaction. The Applicant respectfully points out that claim 1 recites means for storing funds transfer status data, and so includes corresponding structure described in the specification and equivalents thereof. Funds transfer data and processing host 40 generates funds transfer data 50, by appending funds transfer static data 54 and funds transfer status data 52 to payment input data 12, after verifying that the customer ID is current and valid and corresponds to a valid identification number. See US 2002/0055907 – Figure 1; [0030].

Withdrawal of the rejection of claims 1, 17, and 22 under 35 U.S.C. §112, second paragraph, is respectfully requested.

35 U.S.C. §103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See MPEP 2143. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP 2143.03. The Applicants respectfully assert that the cited reference fails to do so.

Claims 1-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,078,907 to Lamm (the *Lamm* patent) in view of U.S. Patent No. 6,173,272 to Thomas, *et al.* (the *Thomas* patent).

The Applicants respectfully assert that the *Lamm* patent and the *Thomas* patent, alone or in combination, fail to teach or suggest all the claim limitations. The *Lamm* patent is directed to a system and method for preparing and electronically delivering a bill to a billed party. See Abstract. The *Thomas* patent is directed to a funds transfer system for facilitating electronic funds transfer between a payor and a payee by means of an intermediate trusted third party and is limited to use with an Automated Clearing House (ACH) system with an intermediate trusted third party. See Abstract, Figure 2A; column 7, lines 52-65. The Applicants' invention is directed to an electronic payment system and method allowing payment by a single action over any electronic funds transfer network and using any pre-

determined local or international electronic funds transfer and settlement network. *See* Abstract.

- A. The *Lamm* patent and the *Thomas* patent fails to disclose, teach, or suggest:
- an electronic payment system for a customer to direct payment over an electronic funds transfer network from an originating bank, comprising:
 - means for receiving payment input data;
 - means for storing funds transfer static data;
 - means for storing funds transfer status data;
 - means for generating funds transfer data from the payment input data, the funds transfer static data, and the funds transfer status data; and
 - means for generating a funds transfer instruction from the funds transfer data, wherein the funds transfer data is appropriate to the originating bank and the electronic funds transfer network, as recited in independent claim 1.

The specific elements are discussed in detail below. While the specification is not to be read into the claims, the verbiage of the claims must be considered to possess their ordinary usage as would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. *See* MPEP 2111.

The *Lamm* patent fails to disclose means for receiving payment input data as recited in independent claim 1, which is defined to include the customer ID, payment amount, and date. *See* US 2002/0055907 – Figure 3; [0016]. At most, the *Lamm* patent discloses receipt of payment instructions 152 by the electronic post office 16. *See* Figure 5; column 15, lines 43-45.

The *Lamm* patent fails to disclose means for storing funds transfer static data as recited in independent claim 1, which is defined to include where the payment funds originate, how they are to be transferred, and where they are to go. *See* US 2002/0055907 - [0012]. At most, the *Lamm* patent discloses building an authentication database 17 containing information so that the billing party and the electronic post office 16 can communicate with the consumer's computer 12, and providing enrollment data that may include secured billing information that will allow a

billing party to debit funds from a consumer's account or charge a consumer's credit account upon authorization from the consumer. *See* Figures 3, 5; column 9, lines 12-57. The *Lamm* patent lacks any disclosure of how the payment funds are to be transferred.

The *Lamm* patent fails to disclose means for storing funds transfer status data as recited in independent claim 1, which records the steps of the payment transaction. *See* US 2002/0055907 - Figure 3; [0017]. At most, the *Lamm* patent discloses that a billing history database 36 may contain billing information that has been transmitted to the consumer computer 12 from the electronic post office 16. *See* Figure 2; column 5, line 67 through column 6, line 67.

The *Thomas* patent fails to disclose means for generating funds transfer data from the payment input data, the funds transfer static data, and the funds transfer status data as recited in independent claim 1, which involves taking payment input data, adding funds transfer static data for the identification number corresponding to the customer ID, adding funds transfer status data, and storing the result as funds transfer data. *See* US 2002/0055907 - [0017]. At most, the *Thomas* patent discloses a lookup, performed by the trusted third party computer system 50 in the central database 14, and substitution in the ACH message of the UID supplied by bank C with the payee's account number and the special identifier with the routing/transit number of the payee's bank B. *See* Figure 2A; column 15, lines 18-25.

The *Thomas* patent fails to disclose means for generating a funds transfer instruction from the funds transfer data, wherein the funds transfer data is appropriate to the originating bank and the electronic funds transfer network as recited in independent claim 1, where the funds transfer interface 62 contains an arrangement of rules and formats for making a transfer from any given bank over any electronic funds transfer network. *See* US 2002/0055907 - [0032]. At most, the *Thomas* patent discloses substitution in the ACH message of the UID supplied by bank C with the payee's account number and the special identifier with the routing/transit number of the payee's bank B. After the substitution is made, the transaction takes the same route as any other ACH transaction in the ACH network. *See* Figure 2A; column 15, lines 18-25. The operation is limited to funds transfer over the ACH network.

Claims 2-16 depend directly or indirectly from independent claim 1 and so include all the elements and limitations of independent claim 1. The Applicants therefore respectfully submit that dependent claims 2-16 are allowable over the *Lamm* patent and the *Thomas* patent for at least the same reasons as set forth above with respect to independent claim 1.

Regarding dependent claim 2, the *Lamm* patent and the *Thomas* patent fail to disclose funds transfer business logic, such as funds transfer business logic 64 to determine the least cost or most expeditious method to execute the funds transfer. *See* US 2002/0055907 – [0032].

Regarding dependent claim 3, the *Lamm* patent and the *Thomas* patent fail to disclose the funds transfer static data comprising bank funds transfer information.

Regarding dependent claim 4, the *Lamm* patent and the *Thomas* patent fail to disclose the funds transfer static data comprising credit card funds transfer information.

Regarding dependent claims 8-10, the *Lamm* patent and the *Thomas* patent fail to disclose the payment button appearing on a merchant Web page, the payment button appearing in an electronic wallet, the payment button providing a blank for the customer to enter a customer ID.

Regarding dependent claim 11, the *Lamm* patent and the *Thomas* patent fail to disclose the customer provides the payment input data over a wireless communications network.

Withdrawal of the rejection of claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over the *Lamm* patent in view of the *Thomas* patent is respectfully requested.

- B. The *Lamm* patent and the *Thomas* patent also fail to disclose, teach, or suggest:
- an electronic payment method for a customer to direct payment over an electronic funds transfer network from an originating bank, comprising the steps of:
 - establishing funds transfer static data;
 - completing a transaction to the point of payment;
 - pushing a payment button to transmit payment input data;
 - creating funds transfer status data;
 - adding the funds transfer static data and the funds transfer status data to the payment input data to form funds transfer data;
 - monitoring the funds transfer data and conditions;

extracting funds transfer instructions from the funds transfer data by applying a funds transfer interface when the conditions are met; and
sending the funds transfer instructions to the originating bank, as recited in independent claim 17.

The specific elements are discussed in detail below. While the specification is not to be read into the claims, the verbiage of the claims must be considered to possess their ordinary usage as would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. *See* MPEP 2111.

The *Lamm* patent fails to disclose establishing funds transfer static data as recited in independent claim 17, which includes where the payment funds originate, how they are to be transferred, and where they are to go. *See* US 2002/0055907 - [0012]. At most, the *Lamm* patent discloses building an authentication database 17 containing information so that the billing party and the electronic post office 16 can communicate with the consumer's computer 12, and providing enrollment data that may include secured billing information that will allow a billing party to debit funds from a consumer's account or charge a consumer's credit account upon authorization from the consumer. *See* Figures 3, 5; column 9, lines 12-57.

The *Lamm* patent fails to disclose completing a transaction to the point of payment as recited in independent claim 17, which involves selecting the items to be purchased or the bill to be paid and calculating a final payment amount. *See* US 2002/0055907 - [0014]. At most, the *Lamm* patent discloses presentment 92 of the bill to the consumer. *See* Figure 5; column 10, lines 13-17.

The *Lamm* patent fails to disclose pushing a payment button to transmit payment input data as recited in independent claim 17, which sends the funds transfer data and processing host 40 payment input data 12 through the single action of pushing payment button 22. *See* US 2002/0055907 - [0027]. At most, the *Lamm* patent discloses that the consumer electronically pays the bill by preparing an EPO-mail payment instruction message. *See* Figure 5; column 10, lines 13-17.

The *Thomas* patent fails to disclose creating funds transfer status data as recited in independent claim 17, which records the steps of the payment transaction. *See* US 2002/0055907 - Figure 3; [0017]. The *Thomas* patent is silent as to tracking the progress of the funds transfer.

The *Thomas* patent fails to disclose adding the funds transfer static data and the funds transfer status data to the payment input data to form funds transfer data as recited in independent claim 17, which involves taking payment input data, adding funds transfer static data for the identification number corresponding to the customer ID, adding funds transfer status data, and storing the result as funds transfer data. *See* US 2002/0055907 - [0017]. At most, the *Thomas* patent discloses a lookup, performed by the trusted third party computer system 50 in the central database 14, and substitution in the ACH message of the UID supplied by bank C with the payee's account number and the special identifier with the routing/transit number of the payee's bank B. *See* Figure 2A; column 15, lines 18-25.

The *Thomas* patent fails to disclose monitoring the funds transfer data and conditions as recited in independent claim 17, which includes checking the funds transfer status data of the funds transfer data to determine when the funds transfer instruction should be generated and sent. *See* US 2002/0055907 - [0018]. The *Thomas* patent is silent as to monitoring conditions to determine when the funds transfer instruction should be generated and sent.

The *Thomas* patent fails to disclose extracting funds transfer instructions from the funds transfer data by applying a funds transfer interface when the conditions are met as recited in independent claim 17, where the funds transfer interface 62 contains an arrangement of rules and formats for making a transfer from any given bank over any electronic funds transfer network. *See* US 2002/0055907 - [0032]. At most, the *Thomas* patent discloses substitution in the ACH message of the UID supplied by bank C with the payee's account number and the special identifier with the routing/transit number of the payee's bank B. *See* Figure 2A; column 15, lines 18-25.

The *Thomas* patent fails to disclose sending the funds transfer instructions to the originating bank as recited in independent claim 17. *See* US 2002/0055907 - [0019]. At most, the *Thomas* patent discloses the transaction taking the same route as any other ACH transaction in the ACH network. *See* Figure 2A; column 15, lines 18-25. The operation is limited to funds transfer over the ACH network.

Claims 18-21 depend directly or indirectly from independent claim 1 and so include all the elements and limitations of independent claim 17. The Applicants therefore respectfully submit that dependent claims 18-21 are allowable over the *Lamm* patent for at least the same reasons as set forth above with respect to independent claim 17.

Regarding dependent claim 20, the *Lamm* patent and the *Thomas* patent fail to disclose checking biometric information.

Regarding dependent claim 21, the *Lamm* patent and the *Thomas* patent fail to disclose checking a software key.

Withdrawal of the rejection of claims 17-21 under 35 U.S.C. §103(a) as being unpatentable over the *Lamm* patent in view of the *Thomas* patent is respectfully requested.

- C. The *Lamm* patent and the *Thomas* patent also fail to disclose, teach, or suggest:
- a computer readable medium storing a computer program for electronic payment, the computer program comprising:
 - computer readable code for establishing funds transfer static data;
 - computer readable code for completing a transaction to the point of payment;
 - computer readable code for pushing a payment button to transmit payment input data;
 - computer readable code for creating funds transfer status data;
 - computer readable code for adding the funds transfer static data and the funds transfer status data to the payment input data to form funds transfer data;
 - computer readable code for monitoring the funds transfer data and conditions;
 - computer readable code for extracting funds transfer instructions from the funds transfer data by applying a funds transfer interface when the conditions are met; and

computer readable code for sending the funds transfer instructions to the originating bank, as recited in independent claim 22.

The specific elements of independent claim 22 are discussed in Section B above for the parallel elements of independent claim 17.

Claim 23 depends directly from independent claim 22 and so includes all the elements and limitations of independent claim 22. The Applicants therefore respectfully submit that dependent claim 23 is allowable over the *Lamm* patent for at least the same reasons as set forth above with respect to independent claim 22.

Withdrawal of the rejection of claims 22-23 under 35 U.S.C. §103(a) as being unpatentable over the *Lamm* patent in view of the *Thomas* patent is respectfully requested.

SUMMARY

Reconsideration he rejection of claims 1-23 is respectfully requested in light of the remarks herein. The Applicants submit that claims 1-23 fully satisfy the requirements of 35 U.S.C. §§102, 103, and 112. In view of foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,

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